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PATENT

Attorney Docket No. 90099012
A&B No.: ALL/023-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: |) | |
| BEDDOME et al. |) | Group Art Unit: 3743 |
| |) | |
| Entitled: HEAT EXCHANGER WITH |) | Examiner: Duong, T. |
| MANIFOLD TUBES FOR |) | |
| STIFFENING AND LOAD |) | |
| BEARING |) | |
| |) | |
| Serial No.: 09/864,581 |) | |
| |) | |
| Filing Date: May 24, 2001 |) | |
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TECHNOLOGY CENTER R3700

RESPONSE TO OFFICE ACTION DATED 05/21/02

Commissioner for Patents
Washington, D.C. 20231

Sir:

Claims 27-52 are now in this application. In the concurrently filed Preliminary Amendment, Claims 1-26 have been canceled without prejudice and new Claims 27-52 have been added. No new matter has been added.

In the Office Action dated May 21, 2002 (paper no. 5), the Examiner states that the above-referenced application "contains

claims directed to the following patentably distinct species of the claimed invention: the species are identified as follow: Species A: figures 3-6; Species B: figure 8; Species C: figure 9." (O/A dated 5/21/02, p. 2, ¶ 1). Further, the Examiner comments that "[i]f the applicant elects species A, a further election of sub species of figures 10a, 10b, 10c and 10d will be required." (O/A, p. 2, ¶ 2). In support of his election of species requirement the Examiner states that "[c]urrently, none of the claims are generic". (O/A, p. 2, ¶ 3).

As set forth in further detail herein, the Applicants respectfully disagree with the Examiner's contention that "none of the claims are generic". (O/A, p. 2, ¶ 3). Specifically, the Applicants contend that several generic claims were present in the application as originally filed, including Claims 1-6. However, to expedite the prosecution of the Applicants' invention, the Applicants have in the concurrently filed Preliminary Amendment, canceled without prejudice all the original claims (Claims 1-26). The Applicants have added new Claims 27-52, which include claims generic to all the species (Species A-C and the sub-species) previously identified by the Examiner. The Applicants respectfully request the addition to the application of these new claims. Support for these added claims can be found in the Applicants' specification. No new matter has been added.

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Provisional Election of Species

The Applicants provisionally elect the species of figures 3-6 and sub-species of figure 10a.

New claims 27-28, 30-32, 34-37, 41-46, 47-48 and 50-52 are readable on the provisionally elected species.

Application Contains Claims Generic to all Species

As noted above, the Applicants respectfully contend that the application as amended contains generic claims to each of the species identified by the Examiner. As a result, the Applicants request that the Examiner withdraw his election of species requirement and allow claims to all identified species to remain in the application.

MPEP Section 806.04(d) identifies a generic claim as one which reads on each of the views of different species. However, a claim which sets forth only an element or subcombination which is common to the species is not generic to the species. MPEP § 806.04(d).

"In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species". MPEP § 806.04(d). Further, "the generic claim cannot include limitations not present in each of the

added species claims." MPEP § 806.04(d). That is, the claims of the additional species must contain all the limitations of the generic claim. MPEP § 806.04(d).

In the application as amended by the concurrently filed Preliminary Amendment, the new independent claims 27, 47 and 52 are each are generic to the three species and four sub-species identified by the Examiner in his Office Action. Further, new dependent claims 30, 31, 34-36, 41-43, 45, 46, 50 and 51 are each generic to each of the species and sub-species.

As noted above, one requirement of MPEP § 806.04(d) is that for a claim to be generic it must read on each of the different species. Independent Claims 27, 47 and 52 clearly read on each of the species set forth by the Examiner. That is, the species are within the scope of the independent claims.

Claim 27, for example, reads on Species A (figures 3-6), Species B (figure 8) and Species C (figure 9), which each include: a core with a heat exchange portion; a tube with a portion extending into the core, which is capable of being in contact with the core to provide support to the core and to increase the stiffness of the core, and the tube is positioned adjacent to the heat exchange portion; a load bearing member which is adjacent the core; and a first mount positioned between the tube and the load bearing member, so that the load bearing member can receive loads from the tube. It is important to note that since figure 8 (e.g. Species B), is shown in a top cross-section, and as a result some of the structure is not shown.

However review of the specification (e.g. p. 20, l. 15 to p. 21, l. 10) shows that the description of the embodiments set forth in figure 8 are read upon by Claim 27. In a similar manner, Independent Claims 47 and 52 also read on Species A, B and C. Therefore, the requirement that the generic claims read on the species is met in the present application.

Another requirement of Section 806.04(d) is that a generic claim must not merely set forth an element or subcombination which is common to the species. Here, Claims 27, 47 and 52 each have a set elements which define the present invention and do not merely set forth an element or subcombination of the species. As such, this requirement for generic claims is met.

In addition, under MPEP § 806.04(d), generally a generic claim should include no material elements additional to those recited in the species claims and must comprehend within its confines the organization covered in each of the species. Section 806.04(d) states "the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim." A simple review of claims 27, 47 and 52 clearly show that they contain no additional material elements over the species claims. In fact, since all the species claims depend from these generic claims, the species claims include all the elements and limitations of the generic claims from which they each depend.

Also, it is clear that the claims 27, 47 and 52 comprehend the organization of the species. For example, independent Claim